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EXAMINER

CHU, KIM KWOK

| ART UNIT | PAPER NUMBER |
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2653

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/715,009

Applicant(s)

YAMAUCHI, KEIICHI

Examiner

Kim-Kwok CHU

Art Unit

2653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/25/03 (paper 6).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9,21 and 25 is/are allowed.
- 6) ☒ Claim(s) 1-8,10-20,22-24 and 26-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Remarks

1. Applicant's Remarks filed on August 25, 2003 have been fully considered but they are not persuasive.

(a) Applicant states that the cited prior art of Nagashima does not disclose recording audio data from one recording medium to another recording medium in parallel with reproducing recorded audio data from the second medium (page 23 of the Remarks, lines 15-17). Accordingly, Nagashima discloses a system of two recording/reproducing units where audio data is dubbed. With respect to the feature of the audio dubbing "in parallel" with reproducing recorded audio data from the second medium, Nagashima's decoder 21 reproduces the recorded audio data in parallel with the recording process (column 7, lines 36-44). For example, Nagashima teaches that "the reproduced data are written in the memory 22 at the transmission rate of 75 sectors/second and the reproduced data are continuously read from the memory 22 at the transmission rate of 75 sectors/second (column 7, lines 45-48); and

(b) on page 23 of the Remarks, last paragraph, Applicant cited the Nagashima's column 7, lines 45-59 is not correct. The cited passage is column 7, lines 3-14. Accordingly, the description in column 7, lines 5-8, "so that the recording data read out a burst fashion will be continuously recorded on the recording track of the magneto-optical disc 2" discloses that

the feature of the audio dubbing "in parallel" with reproducing recorded audio data from the second medium.

Claim Objections

2. Claims 30-34 are objected to because of the following informalities:

(a) in claim 31, last line, the term "by the compressing device" should be changed to --by a compressing device--;

(b) in claim 32, last line, the term "by the compressing method converter" should be changed to --by a compressing method converter--;

(c) in claim 33, last two lines, the term "by the compressing device" should be changed to --by a compressing device--; and

(d) in claim 34, last line, the term "by the compressing method converter" should be changed to --by a compressing method converter--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

4. Claims 1-7, 10, 11, 28 and 31-35 are rejected under 35 U.S.C. § 102(b) as being anticipated by Nagashima et al. (U.S. Patent 5,963,521).

Nagashima teaches an information recording and reproducing apparatus having all of the elements and means as recited in claims 1-5 and 10. For example, Nagashima teaches the following:

(a) as in claim 1, a first reproducing device 33 for reproducing audio information from a first information record medium 32, in which the audio information is recorded (Fig. 1; the first reproducing device 33 is the playback unit; column 3, lines 40-42);

(b) as in claim 1, a recording device 3 for recording the reproduced audio information into a second information record medium 2 (Fig. 1; column 4, lines 30-32);

(c) as in claim 1, a second reproducing device 3 for reproducing the audio information recorded in the second information record medium 2 (Fig. 1; column 4, lines 41-43);

(d) as in claim 1, a controlling device 7 for setting a recording speed when recording the audio information into the second information record medium 2 and a reproducing speed when reproducing the audio information from the second information record medium 2 (Fig. 1; device 7 sets the operating mode such as a high speed dubbing mode and audio playback mode);

(e) as in claim 1, controlling the recording speed is equal to or higher than the reproducing speed (Fig. 1; recording data requires less time than playback the data);

(f) as in claim 1, controlling the second reproducing device 3 and the recording 3 device so as to perform reproducing the recorded audio information from the second information record medium 2 at the set reproducing speed in parallel to recording the audio information into the second information record medium 2 at the set recording speed (Fig. 1; column 7, lines 45-59);

(g) as in claim 2, the controlling device 7 sets the recording speed and the reproducing speed such that the recording speed is equal to or faster than two times the reproducing speed (Fig. 1; recording is in a burst mode of compressed data which is $\frac{1}{4}$ of standard data format; column 5, lines 55-61);

(h) as in claim 3, the controlling device 7 sets the recording speed and the reproducing speed equal to each other (Fig. 1; recording and reproducing on medium 2 is under the same medium rotational speed by a motor M);

(i) as in claim 3, controls the second reproducing device 3 and the recording device so that the second reproducing device 3 starts reproducing after the recording device starts recording (Fig. 1; data is recorded first and then it can be playback by a user);

(j) as in claim 4, the controlling device 7 controls the first reproducing device 33 and the recording device so as to convert a form of the audio information reproduced from the first information record medium 32 and then record the audio information into the second information record medium 2 (Fig. 1; conversion is done by decoder 41 and encoder 15);

(k) as in claim 5, the controlling device 7 controls the recording device so as to compress the audio information, which is reproduced by the first reproducing device 33, and record the compressed audio information into the second information record medium 2, and controls the second reproducing device 3 so as to reproduce the audio information from the second information record medium 2, expand the reproduced audio information and output the reproduced and expanded audio information to an external portion 26 (Fig. 1; ADPCM expands the compressed audio information);

(l) as in claim 10, the first information record medium 32 comprises an optical disc, and the second information record

medium 2 comprises a magnetic disc (Fig. 1; disc 2 is a magneto-optical disc which is written/reproduced by a magnetic head 16).

5. Claims 6 and 7 have limitations similar to those treated in the above rejection, and are met by the references as discussed above. Claims 6 and 7 however also recite the following limitations which are also taught by the prior art:

(a) as in claim 6, the controlling device 7 controls the recording device 3 so as to record information indicative of a portion of the audio information, which is being recorded at a time of stopping a recording operation of recording the audio information into the second information record medium 2, into the second information record medium 2 and then stop the recording operation, when the recording operation is to be stopped in a middle of recording the audio information into the second information record medium 2 (Fig. 1; burst mode recording); and

(b) as in claim 7, the controlling device 7 controls the recording device so as to output stop information indicative of stopping the recording operation to an external portion, when the recording operation is to be stopped in the middle (Fig. 1; user input 8 sends control signals such as positions of start/stop; column 7, lines 1-10).

6. Claim 11 has limitations similar to those treated in the above rejection, and is met by the references as discussed

above. Claim 11 however also recites the following limitations which are also taught by the prior art:

(a) as in claim 11, the second information record medium 2 having map information to control a navigation function is further recorded (Figs. 2 and 3, header and subcode are map information of the medium 2); and

(b) as in claim 11, a navigation device 8 for controlling the navigation function by using the map information (Fig. 1).

7. Method claim 28 is drawn to the method of using the corresponding apparatus claimed in claim 1. Therefore method claim 28 corresponds to apparatus claim 1 and is rejected for the same reasons of anticipation as used above.

8. Claims 31-35 have limitations similar to those treated in the above rejection, and are met by the references as discussed above.

9. Claims 12-14 are rejected under 35 U.S.C. § 102(b) as being anticipated by Nagashima et al. (U.S. Patent 5,963,521).

Nagashima teaches an information recording and reproducing apparatus having all of the elements and means as recited in claims 12-14. For example, Nagashima Giddings teaches the following:

(a) as in claim 12, a first reproducing device 33 for reproducing audio information from a first information record medium 32, in which the audio information is recorded (Fig. 1);

(b) as in claim 12, a recording device 3 for recording the reproduced audio information into a second information record medium 2 (Fig. 1);

(c) as in claim 12, a second reproducing device 3 for reproducing the audio information recorded in the second information record medium 2 (Fig. 1);

(d) as in claim 12, a controlling device 7 for controlling the recording device to record the audio information, which is reproduced from the first information record medium 32 by the first reproducing device 33, when the audio information is outputted as a sound and also controlling the second reproducing device 3 to reproduce and output the audio information as the sound (Fig. 1);

(e) as in claim 13, a converting device for converting a form of the audio information, wherein the controlling device

controls the converting device and the recording device to convert the form of the audio information and then record the audio information when recording the audio information reproduced by the first reproducing device into the second information record medium (Fig. 1);

(f) as in claim 14, a compressing device 13 for compressing the audio information; and an expanding device 23 for expanding the compressed audio information (Fig. 1);

(g) as in claim 14, the controlling device 7 controls the compressing device 13 and the recording device 3 to compress the audio information and then record the compressed audio information when recording the audio information, which is reproduced by the first reproducing device 33, into the second information record medium 2 (Fig. 1); and

(h) as in claim 14, the controlling device 7 controls the second reproducing device 3 and the expanding device 23 to reproduce the compressed audio information, expand the reproduced audio information and then output the expanded audio information as a sound (Fig. 1).

10. Claims 15-20, 22, 23, 26 and 27 are rejected under 35 U.S.C. § 102(b) as being anticipated by Nagashima et al. (U.S. Patent 5,963,521).

Nagashima teaches an information recording and reproducing apparatus having all of the elements and means as recited in claims 15-20 and 26. For example, Nagashima teaches the following:

(a) as in claim 15, a reproducing device 33 for reproducing audio information from a first information record medium 32, in which the audio information is recorded (Fig. 1);

(b) as in claim 15, a recording device 3 for recording the reproduced audio information into a second information record medium 2 (Fig. 1);

(c) as in claim 15, a controlling device 7 for controlling the reproducing device 33 and the recording device 3 so as to perform recording the reproduced audio information into the second information record medium 2 in parallel to reproducing the audio information from the first information record medium 32 (Fig. 1);

(d) as in claim 16, a converting device 15 for converting a form of the audio information, which is reproduced from the first information record medium 32, wherein the recording device 3 records the converted audio information into the second information record medium 2 (Fig. 1);

(e) as in claim 17, the audio information is recorded in the first information record medium 32 in a non-compressed state (Fig. 1; information stored in normal CD-ROM 32 is not compressed);

(f) as in claim 17, the recording device 3 compresses the audio information in the non-compressed state and then records the compressed audio information into the second information record medium 2 (Fig. 1; device 13 compresses the audio information);

(g) as in claim 18, the audio information is recorded in the first information record medium 32 in a compressed state, the reproducing device comprises an expanding device for expanding the audio information in the compressed state, and the recording device 3 records the expanded audio information into the second information record medium 2 (Fig. 1; column 2, lines 28-49);

(h) as in claim 19, the audio information is recorded in the first information record medium 32 in a compressed state, the reproducing device 3 comprises a decoding device 21, 23 for expanding and decoding the audio information in the compressed state, and the recording device 3 again compresses the expanded and decoded audio information and then records the again compressed audio information into the second information record medium (Fig. 1; process of dubbing the dubbed medium 2 again);

(i) as in claim 20, the audio information is recorded in the first information record medium 32 in a compressed state, and the recording device 3 records the audio information in the compressed state into the second information record medium 2 (Fig. 1; column 2, lines 28-49); and

(j) as in claim 26, the first information record medium 32 comprises an optical disc, and the second information record medium comprises a magnetic disc (Fig. 1; disc 2 is a magneto-optical disc which is written/reproduced by a magnetic head 16).

11. Claims 22 and 23 have limitations similar to those treated in the above rejection, and are met by the references as discussed above. Claims 22 and 23 however also recite the following limitations which are also taught by the prior art:

(a) as in claim 22, the controlling device 7 controls the recording device so as to record information indicative of a portion of the audio information, which is being recorded at a time of stopping a recording operation of recording the audio information into the second information record medium 2, into the second information record medium and then stop the recording operation, when the recording operation is to be stopped in a middle of recording the audio information into the second information record medium (Fig. 1; burst mode recording); and

(b) as in claim 23, the controlling device 7 controls the

recording device 3 so as to output stop information indicative of stopping the recording operation to an external portion, when the recording operation is to be stopped in the middle (Fig. 1; user input 8 sends control signals such as positions of start/stop; column 7, lines 1-10).

12. Claim 27 has limitations similar to those treated in the above rejection, and is met by the references as discussed above. Claim 27 however also recites the following limitations which are also taught by the prior art:

(a) as in claim 27, on the second information record medium, map information to control a navigation function is further recorded, and the information recording and reproducing apparatus further comprises a navigation device for controlling the navigation function by using the map information (Figs. 2 and 3, header and subcode are map information of the medium 2).

13. Claim 29 is rejected under 35 U.S.C. § 102(b) as being anticipated by Nagashima et al. (U.S. Patent 5,963,521).

Nagashima teaches an information recording and reproducing method having all of the steps as recited in claim 29. For example, Nagashima teaches the following:

(a) as in claim 29, a first reproducing process of reproducing audio information from a first information record medium 32, in which the audio information is recorded (Fig. 1);

(b) as in claim 29, a recording process of recording the reproduced audio information into a second information record medium 2 (Fig. 1; dubbing process);

(c) as in claim 29, a second reproducing process of reproducing the audio information recorded in the second information record medium 2 (Fig. 1; audio output 26);

(d) as in claim 29, a controlling process 7 of controlling the recording process to record the audio information, which is reproduced from the first information record medium 32 by the first reproducing process, when the audio information is outputted as a sound (Fig. 1; audio output 46); and

(e) as in claim 29, controlling the second reproducing process to reproduce and output the audio information as the sound (Fig. 1; audio output 26).

14. Claim 30 is rejected under 35 U.S.C. § 102(b) as being anticipated by Nagashima et al. (U.S. Patent 5,963,521).

Nagashima teaches an information recording and reproducing method having all of the steps as recited in claim 30. For example, Nagashima teaches the following:

(a) as in claim 30, a reproducing process of reproducing audio information from a first information record medium 32, in which the audio information is recorded (Fig. 1);

(b) as in claim 30, a recording process of recording the reproduced audio information into a second information record medium 2 (Fig. 1); and

(c) as in claim 30, a controlling process of controlling the reproducing process and the recording process so as to perform recording the reproduced audio information into the second information record medium 2 in parallel to reproducing the audio information from the first information record medium 32 (Fig. 1; data is reproduced via decoder 41 and then recorded and reproduced by the second recording/reproducing device 3).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagashima et al. (U.S. Patent 5,963,521) in view of Yokota (U.S. Patent 5,886,957).

Nagashima teaches an optical data storage system for writing and/or reading information with respect to an optical storage medium very similar to the instant invention. For example, Nagashima teaches the following:

(a) as in claim 8, the recording operation is stopped by stopping a main electric power supplying device for supplying an electric power to the information recording and reproducing apparatus in a normal operation (power switch is an inherent feature to control the supply of electricity).

However, Nagashima does not teach the following:

(a) as in claim 8, a sub electric power supplying device for supplying an electric power to the information recording and

reproducing apparatus after the main electric power supplying device is stopped.

Yokota teaches a data storage apparatus having a stand-by power to keep a controller responsive (column 9, lines 61-64).

There is an advantage for a system to response to an input or event even its power is turned off. For example, Yokota teaches a stand-by power for monitoring a card detector. Similarly, when Nagashima's recording/reproducing operations required to be wake up by the input 8 and display 9 after its main power is turned off, it would have been obvious to one of ordinary skill in the art to use a sub electric power (stand-by power) such as Yokota's, because the sub electric power keeps the input device responsive even the main power is turned off.

17. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagashima et al. (U.S. Patent 5,963,521) in view of Yokota (U.S. Patent 5,886,957).

Nagashima teaches an optical data storage system for writing and/or reading information with respect to an optical storage medium very similar to the instant invention. For example, Nagashima teaches the following:

(a) as in claim 24, the recording operation is stopped by stopping a main electric power supplying device for supplying an electric power to the information recording and reproducing

apparatus in a normal operation (power switch is an inherent feature to control the supply of electricity).

However, Nagashima does not teach the following:

(a) as in claim 24, a sub electric power supplying device for supplying an electric power to the information recording and reproducing apparatus after the main electric power supplying device is stopped.

Yokota teaches a data storage apparatus having a stand-by power to keep a controller responsive (column 9, lines 61-64).

There is an advantage for a system to response to an input or event even its power is turned off. For example, Yokota teaches a stand-by power for monitoring a card detector.

Similarly, when Nagashima's recording/reproducing operations required to be wake up by the input 8 and display 9 after its main power is turned off, it would have been obvious to one of ordinary skill in the art to use a sub electric power (stand-by power) such as Yokota's, because the sub electric power keeps the input device responsive even the main power is turned off.

Allowable Subject Matter

18. Claims 9, 21 and 25 are allowable over prior art.

19. The following is an Examiner's statement of reasons for the indication of allowable subject matter:

As in claim 9, the prior art of record fails to teach or fairly suggest a compressing device for reproducing the recorded audio information from the second information record medium, compressing the reproduced audio information, and recording again the compressed reproduced audio information into the second information record medium.

As in claim 21, the prior art of record fails to teach or the audio information is recorded in the first information record medium in a compressed state based on a first compressing method, and the recording device records the audio information in a compressed state based on a second compressing method, which is different from the first compressing method, into the second information record medium.

As in claim 25, the prior art of record fails to teach or fairly suggest a compressing device for judging the audio information which is recorded in a non-compressed state from among the audio information recorded in the second information record medium, reproducing the judged audio information in the non-compressed state from the second information record medium,

compressing the reproduced audio information by applying a predetermined compressing process onto the reproduced audio information, and recording again the compressed audio information into the second information record medium.

The features indicated above, in combination with the other elements of the claims, are not anticipated by, nor made obvious over, the prior art of record.

20. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action.

In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action

21. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks Washington, D.C.
20231 Or faxed to:

(703) 872-9306 (for formal communications intended for entry. Or:

(703) 746-6909, (for informal or draft communications, please label "PROPOSED" or "DRAFT")


Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim CHU whose telephone number is (703) 305-3032 between 9:30 am to 6:00 pm, Monday to Friday.

1cc 11/28/03
Kim-Kwok CHU
Examiner AU2653
November 28, 2003

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